

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/050,112
Attorney Docket No. Q66502

REMARKS

Claims 1-19 are all the claims pending in the application.

To summarize, in the second, non-final Office Action, the Examiner rejects claim 14 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner rejects claim 1 under 35 U.S.C. § 102(b) as being anticipated by Martin (U.S. Patent No. 3,606,185) and claims 11, 12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Olsen (U.S. 3,655,145).

Additionally, the Examiner rejects claim 2 under 35 U.S.C. § 103(a) as being obvious over Martin, claims 3 and 4 under 35 U.S.C. § 103(a) as being obvious over Martin in view of Del Genio (U.S. Patent No. 6,034,850), claims 5-7 under 35 U.S.C. § 103(a) as being obvious over Martin in view of Egan, claims 13 and 19 under 35 U.S.C. § 103(a) as being obvious over Olsen, and claims 8-10, 14, and 16-18 under 35 U.S.C. § 103(a) as being obvious over Martin in view of Olsen. Applicants comments on the individual rejections are as follows.

I. Preliminary Matters

As a preliminary matter, Applicants would like to thank the Examiner for indicating that the proposed drawing corrections and corrected drawings filed on February 28, 2003 are accepted and approved.

II. Indefiniteness Rejection

The Examiner rejects claim 14 under 35 U.S.C. § 112, second paragraph, as being indefinite. Therefore, Applicants amend claim 14 merely to provide proper antecedent basis. Accordingly, Applicants request that the Examiner withdraw this rejection.

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III. Anticipation Rejections

A. Claim 1:

The Examiner maintains the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Martin (U.S. Patent No. 3,606,185). For at least the following reasons, Applicants traverse this rejection.

Claim 1 relates to a single reel magnetic tape cartridge having a reduced number of components and having a reduced overall thickness, thereby reducing manufacturing costs.

Applicants submit that Martin clearly does not disclose or suggest all of the recitations of independent claim 1.

For example, the cartridge 200 of Martin includes (as shown in Figures 1 to 13) a rotatable cup or holder 206 that seemingly is comparable to the claimed “lower case”, a retaining plate 210 for supporting the lower surface of a roll 204 made of a strip material 202 that seemingly is comparable to the claimed “lower flange”, and a rotatable top plate 208 that seemingly is comparable to the claimed “upper flange”, of claim 1. However, Applicants note that the top plate 208 constitutes the entire top surface of the cartridge 200. Thus, Martin clearly does not disclose or suggest at least a member that is comparable to the “upper case” recited in claim 1, which is separate from the claimed “upper flange”. Thus, Martin clearly does not anticipate independent claim 1.

As a further example, the retaining plate 210 and the top plate 208 of Martin, while integrally configured to form a single reel in the cartridge 200, are separated from each other during use, and thus, do not rotate integrally. Instead, the retaining plate 210 is separated from

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the top plate 208 and set into the holder 206 integrally, thereby being rotated together with the holder 206 during use. In addition, while the single reel of the claimed invention is rotatable during use, the cartridge case accommodating the single reel therein is not rotatable. Thus, for at least the foregoing reasons, Applicants submit that the retaining plate 210 is not comparable to the claimed “lower flange”, but instead, clearly is different than the “lower flange” of the claimed invention.

On the other hand, the cartridge 300 of Martin (as shown in Figures 14 to 16) includes a top plate 310, a cup or holder 312, and a core 314 of a roll of a strip material 302, whose surface is supported by an inner lower surface of the holder 312. In other words, Martin does not disclose a lower flange for supporting the lower surface of the roll of the strip material 302, and thus, does not disclose the claimed “single reel”. Moreover, since the top plate 310 constitutes an entire top surface of the cartridge 300, Martin clearly does not disclose a member comparable to the claimed “upper case”, which is separated from the claimed “upper flange”.

For at least the foregoing reasons, Applicants submit that Martin clearly does not disclose or suggest all of the recitations of independent claim 1, and therefore, request the Examiner to withdraw this rejection. Additionally, to facilitate early allowance of the present application, Applicants amend independent claim 1 to define more thoroughly the features of the claimed invention.

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B. Claims 11, 12, and 15:

Further, the Examiner rejects claims 11, 12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Olsen (U.S. 3,655,145). For at least the following reasons, Applicants traverse this rejection.

As a preliminary matter, Applicants amend claims 11 and 12 to define more thoroughly the features of the claimed invention. In particular, claim 11 is amended to incorporate some of the recitations of claim 12, while claim 12 is amended to incorporate some of the recitations from claim 19. Additionally, Applicants change the dependency of claim 15 to depend from claim 12.

Applicants submit that Olsen neither discloses nor suggests a magnetic tape drawing-out port that is provided at a position apart from the corner and located between a position corresponding to a screw hole (compared by the Examiner to holes 32 of Olsen) used for assembling upper and lower cases and provided in the corner of the cartridge case, and a position corresponding to a reference hole (compared by the Examiner to the slot 56 of Olsen) provided in the vicinity of a central portion of the cartridge case, as recited in claim 11 (as amended), as recited in claim 11. In fact, Olsen does not disclose a reference hole, as recited in claim 11. That is, the slot 56 clearly is not a reference hole, as recited in claim 11 and defined by Applicants' specification and drawings. On the contrary, the slot 56 merely is the opening of the case through which the tape exits the case, not a reference hole.

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For at least the foregoing reasons, Applicants submit that claim 11 and dependent claims 12 and 15 are not anticipated by Olsen, and therefore, request the Examiner to withdraw this rejection.

IV. Obviousness Rejections

A. Claim 2:

The Examiner maintains the rejection of claim 2 under 35 U.S.C. § 103(a) as being obvious over Martin. Applicants submit that claim 2 is patentable over Martin at least by virtue of its dependency from claim 1, and therefore, the rejection of claim 2 should be withdrawn for the reasons set forth above with respect to claim 1.

B. Claims 3 and 4:

Additionally, the Examiner rejects claims 3 and 4 under 35 U.S.C. § 103(a) as being obvious over Martin in view of Del Genio. Applicants submit that Del Genio does not make up for the deficiencies of Martin, and therefore, claims 3 and 4 are patentable at least by virtue of their dependency from claim 1.

C. Claims 5-7:

Further, the Examiner rejects claims 5-7 under 35 U.S.C. § 103(a) as being obvious over Martin in view of Egan. For at least the following reasons, Applicants traverse this rejection.

Claim 5 recites, inter alia, that “at least two reel engaging units are provided on an upper side of said upper case to engage said upper flange and prevent said single reel from being unwantedly disengaged from said cartridge case”.

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In the present Office Action, the Examiner acknowledges that Martin does not disclose the claimed “reel engaging units”. However, the Examiner alleges that Egan makes up for the deficiencies of Martin by disclosing sides of the housing for retaining and protecting the reel. Applicants respectfully disagree.

Applicants submit that the “sides of the housing for retaining and protecting the reel” clearly are not comparable to the claimed “reel engaging units” provided on an upper side of the upper case to engage the upper flange. At best, the side of the housing would be comparable to the sides of the claimed case.

However, assuming *arguendo* that the sides of the housing would have been comparable to the claimed reel engaging units, Applicants respectfully submit that merely identifying individual features of the references that arguably disclose the individual features of the claim is not sufficient to establish obviousness of the claim. On the contrary, the Examiner must establish that there would have been a motivation or suggestion to modify the primary reference based on the disclosure of the secondary reference to arrive at the claimed invention in as complete detail as recited in the claim. Additionally, to render a claim obvious, the alleged combination cannot change the principle of operation of the primary reference or render the primary reference inoperable. That is, it must be not only possible to combine the references, but there also must be a suggestion or motivation to combine the references in the manner recited in the claims and in as complete detail as recited in the claims. Moreover, while the Examiner may interpret the claim language broadly, the Examiner’s interpretation is not without limitation. On the contrary, it is settled law that the language of the claim can be interpreted as broadly as

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reasonably possible based on the specification and claims. Accordingly, Applicants respectfully submit that the present rejection does not provide adequate support to explain the manner in which the device that allegedly would result from the combination of references would arrive at the claimed device and in as complete detail as recited in the claims. Therefore, Applicants request the Examiner to withdraw the rejection of claim 5.

With respect to claim 6, Applicants respectfully submit that the obviousness of this claim has not been established. Particularly, the Present Office Action does not identify any structure in the cited references that corresponds to the features recited in claim 6. For example, claim 6 recites, *inter alia*, that “each of said at least two reel engaging units includes an urging unit for urging said upper flange toward said upper case”. Accordingly, Egan clearly does not disclose or suggest that the alleged sides of the housing for retaining and protecting the reel include an urging unit, as recited in claim 6. Therefore, Applicants request the Examiner to withdraw the rejection of claim 6.

Similarly, with respect to claim 7, a *prima facie* case of obviousness of claim 7 has not been established. Particularly, the present Office Action does not identify any structure in the cited references that corresponds to the features of claim 7. For example, claim 7 recites, *inter alia*, that the “engagement of said upper flange of said single reel by each of said at least two reel engaging units is released when the magnetic tape cartridge is loaded into said recording/reproducing apparatus”. Accordingly, any combination of Martin and Egan clearly would not disclose or suggest at least this recitation; and therefore, Applicants request the Examiner to withdraw the rejection of claim 7.

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D. Claims 13 and 19:

Moreover, the Examiner rejects claims 13 and 19 under 35 U.S.C. § 103(a) as being obvious over Olsen.

With respect to claim 13, Applicants submit that claim 13 is patentable over Olsen at least by virtue of its dependency from claim 11.

With respect to claim 19, Applicants submit that claim 19 also is patentable over Olsen. Applicants submit that claim 19 (as with claim 11) is amended to incorporate the subject matter of original claim 12. Accordingly, Applicants submit that claim 19 is patentable over Olsen at least for reasons that are analogous to the reasons set forth above with respect to claim 11.

Thus, Applicants request the Examiner to withdraw the rejection of claims 13 and 19.

E. Claims 8-10, 14, and 16-18:

Additionally, the Examiner rejects claims 8-10, 14, and 16-18 under 35 U.S.C. § 103(a) as being obvious over Martin in view of Olsen.

Applicant submit that Olsen does not make up for the deficiencies of Martin, and therefore, claims 8-10, 14, and 16-18 are patentable over any combination of Martin and Olsen.

For example, similar to the prior art cartridge disclosed in the present application, the upper flange 62 and the lower flange 64 of Olsen are configured integrally to form a single reel 40 that is accommodated in a cartridge case 12 that is configured integrally with an upper case 16 and lower case 18. Additionally, the side surface is covered except for an opening 56. However, neither the upper flange 62 nor the lower flange 64 forms any part of either the upper case 16 or the lower case 18. Thus, Olsen does not disclose the features of the upper flange or

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upper case, as recited in independent claim 1, from which claims 8-10 and 14 depend, or independent claim 16, from which claims 17 and 18 depend.

Moreover, Applicants submit that Olsen also has different functions and operations from that of the Martin cartridge, and therefore, Olsen does not compensate for the deficiencies of Martin. Accordingly, Applicants submit that there would not have been a motivation or suggestion to combine these two different references.

Additionally, Applicants submit that dependent claims 8-10, 14, 17, and 18 are patentable separately and independently over any combination of Martin and Olsen. For example, with respect to claim 9, Applicants submit that Olsen does not disclose or suggest a drawing-out port that is “provided between a position corresponding to a screw hole used for assembling upper and lower cases and provided in the corner of said cartridge case, and a position corresponding to a reference hole provided on said upper side of said cartridge case in the vicinity of a central portion of said cartridge case”, as recited in claim 9.

As another example, with respect to claim 14, Olsen does not disclose or suggest whether the long leader 74 easily falls apart from the opening 56 or not. Therefore, in view of the purpose and effectiveness, Olsen and the present inventions are totally different from each other. Additionally, Olsen does not teach that the leader 74 fits to close the opening 56, but merely mentions that the size of the leader 74 is bigger than the interval distance between the flanges. Furthermore, as to the rigidity, Olsen only mentions that the leader 74 is more “rigid” than the tape-formed article (web). Thus, Olsen lacks any description as to a technical problem of damaging the opening 56 when the cartridge is dropped carelessly, and therefore, would not have

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suggested the claimed invention as a countermeasure for the technical problem of the damage to the opening 56 when the cartridge is dropped.

In addition, since “web” and “magnetic tape” are completely different from each other and Olsen does not teach any countermeasure to solve the problem of damage on the “web”, Applicants submit that the configuration of the Olsen cartridge has a significantly different purpose from the solution of the present invention, which is to prevent damage of the “magnetic tape” due to physical impact. Accordingly, the present invention would not have been obvious from Martin and Olsen.

Additionally, in the cartridges 200 and 300 of Martin, the leading ends of the strip materials 202 and 302 are first drawn out and the drawn-out leading ends are taken up by the rotating the holders 206 and 312 to be accommodated. Thus, in Martin, a leading end of a strip material is not drawn out from an opening provided at a side surface of the cartridge and the drawn-out strip material is not rewound from its last end to the leading end in a reversed direction through the same opening.

In comparison, in the present invention, the single reel has a last end of a magnetic tape fixed and the magnetic tape is drawn out from the leading end thereof, which is also rewound in the reverse direction through the same opening.

Therefore, for at least the foregoing reasons, Applicants request the Examiner to withdraw the rejection of claims 8-10, 14, and 16-18.

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V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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